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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,218	04/12/2004	C. Douglass Thomas	IPVMA001	1308

34071 7590 02/06/2007  
IPVENTURE, INC.  
5150 EL CAMINO REAL  
SUITE A-22  
LOS ALTOS, CA 94022

EXAMINER
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VUONG, QUOCHIE, B

ART UNIT	PAPER NUMBER
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2618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/822,218

Applicant(s)

THOMAS ET AL.

Examiner

Quochien B. Vuong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/14/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/14/2006 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. (US 6,929,365) in view of Jesiek (US 6,010,216) and Rydbeck (US 5,590,417).

Regarding claim 1, Swab et al. (figures 1, 2a, and 3) disclose a pair of eyeglasses, comprising a frame having a pair of arms and a pair of lense holders (figures 1 and 2a), one or both of the arms having an internal area; wireless communication circuitry (figure 3) provided within the internal area of one or both of the arms; at least one speaker (56) coupled to the wireless communication circuitry, at least a portion of the speaker being provided within the internal area of at least one of the two arms; at least one microphone (54) coupled to the wireless communication circuitry, wherein at least a portion of the at least one microphone being embedded in the frame; at least one battery (52) for powering at least the wireless communication circuitry, wherein the at least one battery is provided within the internal area of at least one of the arms, wherein the at least one battery is provided internal to a first of the arms (column 4, lines 5-18; column 4, line 66- column 5, line 43; and column 5, line 66 – column 6, line 16). Swab et al. do not specifically disclose the pair of eyeglasses comprising a balancing weight provided internal to the internal area of at least one of the arms, and wherein the balancing weight is provided internal to a second of the arms so that the two arms are of substantially the same weight, and wherein the at least one battery is rechargeable. However, Swab et al. do disclose balancing weight for the eyeglasses frame (column 5, line 36-41) by putting battery on one arm and the other circuitry on the other arm. Therefore, it would have been obvious to put an additional balancing weight

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to one or the other arm when necessary for the same purpose of balancing the weight of the eyeglasses to provide comfort the user. And Jesiek discloses a hands free two-way radio communications in the eyeglasses with rechargeable batteries (column 1, lines 46-61; and figures 1 and 2). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the rechargeable batteries of Jesiek to the eyeglasses of Swab et al. in order to save cost by reusing the rechargeable batteries.

Regarding claims 2-7, Swab et al. disclose at least one speaker coupled to the arm of the eyeglasses (figure 8) (column 7, lines 11-23); and if not inherent it would be obvious for the at least one speaker of Swab et al. to be arranged as in claims in order to be in the arm of the eyeglasses and provide communication function to the user.

Regarding claim 8, since the eyeglasses of Swab et al. and Jesiek comprising the rechargeable batteries, it would be obvious for the eyeglasses of Swab et al. and Jesiek to include a power adapter connector in order to charge the rechargeable batteries without removing the batteries from the eyeglasses.

5. Claims 9, 11, 12, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. in view of Jesiek and further in view of Horiguchi (US 7,031,667).

Regarding claims 9, 11, and 12, Swab et al. and Jesiek do not specifically disclose the eyeglasses further comprise at least one light source operation indicator for indicating the operating and that the wireless communication circuitry is in use.

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However, Horiguchi disclose a portable telephone (figure 2) comprising at least one light source operation indicator for indicating the operating and that the wireless communication circuitry is in use (see abstract; column 3, lines 28-45; and column 5, lines 16-58). Therefore it would have been obvious to adapt the at least one light source operation indicator of Horiguchi to the eyeglasses of Swab et al. and Jesiek in order to provide visual indication of the operating state of the communication circuitry of the eyeglasses to the user.

Regarding claim 15, Swab et al. (figures 1, 2a, and 3) disclose a pair of eyeglasses, comprising: a frame having a pair of arms and a pair of lense holders (figures 1 and 2a), one or both of the arms having an internal area; wireless communication circuitry (figure 3) provided within the internal area of one or both of the arms; at least one speaker (56) coupled to the wireless communication circuitry; at least one microphone(54) coupled to the wireless communication circuitry; at least one battery (52) for powering at least the wireless communication circuitry, wherein the at least one battery is provided within the internal area of at least one of the arms (column 4, lines 5-18; column 4, line 66- column 5, line 43; and column 5, line 66 – column 6, line 16). Swab et al. do not specifically disclose the pair of eyeglasses comprising at least one operation indicator configured to indicate an operation of the wireless communication circuitry, and wherein the at least one battery is rechargeable. However, Jesiek discloses a hands free two-way radio communications in the eyeglasses with rechargeable batteries (column 1, lines 46-61; and figures 1 and 2). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was

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made to adapt the rechargeable batteries of Jesiek to the eyeglasses of Swab et al. in order to save cost by reusing the rechargeable batteries. Swab et al. and Jesiek do not disclose at least one operation indicator for indicating an operation of the wireless communication circuitry and wherein the at least one operation indicator is at least partially internal to the frame. However, Horiguchi disclose a wireless communication device (figure 2, portable telephone) comprising at least one operation indicator (light source) for indicating the operating and that the wireless communication circuitry is in use (see abstract; column 3, lines 28-45; and column 5, lines 16-58). Therefore it would have been obvious to adapt the at least one light source operation indicator of Horiguchi to the internal frame of the eyeglasses of Swab et al. and Jesiek to provide a visual indication of the operating state of the communication circuitry of the eyeglasses to the user.

Regarding claims 17-18, Horiguchi discloses the at least operation indicator is a light source to provide the operation state and that the wireless communication circuitry is in use (see abstract; column 3, lines 28-45; and column 5, lines 16-58).

6. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. in view of Jesiek and further in view of Spitzer (US 6,091,546).

Regarding claims 13 and 14, Swab et al. and Jesiek do not specifically disclose the eyeglasses further comprising a position sensor provided within the internal area of at least one of the arms. However, Splitzer discloses an eyeglasses interface system comprising a position sensor provided within the internal area of at least one of the arms

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(column 11, lines 11-23). Therefore, it would have been obvious to adapt the position sensor of Splitzer to the eyeglasses of Swab et al. and Jesiek in order to provide the location information to the user.

7. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. in view of Jesiek and Horiguchi and further in view of Spitzer.

Regarding claims 19 and 20, Swab et al., Jesiek, and Horiguchi do not specifically disclose the eyeglasses further comprising a position sensor provided within the internal area of at least one of the arms. However, Splitzer discloses an eyeglasses interface system comprising a position sensor provided within the internal area of at least one of the arms (column 11, lines 11-23). Therefore, it would have been obvious to adapt the position sensor of Splitzer to the eyeglasses of Swab et al., Jesiek, and Horiguchi in order to provide the location information to the user.

### ***Response to Arguments***

8. Applicant's arguments filed 10/14/2006 have been fully considered but they are not persuasive.

Regarding claim 1, Applicant argues that Swab et al. and Jesiek fail to teach a "balancing weight provided within the internal area of at least one of said arms" and "wherein said at least one battery is provided internal to a first of said arms, wherein said balancing weight is provided internal to a second of said arm so that the two arms are of substantially the same weight". The examiner, however, does not agree with the Applicant. Applicant's attention is directed to Swab et al. (column 5, line 36-41) which



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discloses balancing weight for the eyeglasses frame by putting battery on one arm and the other circuitry on the other arm. The teaching of balancing the weight of Swab et al. on the eyeglasses would lead one of ordinary skilled in the art to put an additional balancing weight to one or the other arm when necessary to the eyeglasses of Swab et al. for the same purpose of balancing the weight of the eyeglasses to provide comfort for the user.

Further, Applicant argues that Swab et al. fail to disclose "at least one speaker coupled to said wireless communication circuitry, at least a portion of said speaker being provided within the internal area of at least one of said two arms". Applicant's attention is directed to Swab et al. (column 5, line 66 –column 6, line 5; and figure 3) which disclose at least one speaker (56) coupled to said wireless communication circuitry (18), at least a portion of said speaker being provided within the internal area of at least one of said two arms (since the speaker is molded into one of the temples of the eyeglasses).

Regarding claim 15, Applicant argues that Swab et al. in view of Jesiek and Horiguchi fail to disclose "at least one operation indicator configured to indicate an operation of the wireless communication circuitry". The examiner, however, does not agree with the Applicant. Applicant's attention is directed to Horiguchi (see abstract; column 3, lines 28-45; and column 5, line 16-58) which discloses an operation indicator (lamp 1) illuminates when the portable phone is functioning in a noncommunicative mode and not illuminate when the portable phone is functioning in a communicating mode.

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Further more, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would be motivated to adapt only the mode indicating lamp of Horguchi to the eyeglasses of Swab and Jesiek for indicating whether the wireless communication circuitry is in used or not. And it also would be obvious for the indicator to be partially internal to the frame of the eyeglasses in order for the user to see.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shurman et al. (US 6,091,832) disclose wearable personal audio loop apparatus.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quochien B. Vuong whose telephone number is (571) 272-7902. The examiner can normally be reached on M-F 9:30-18:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



QUOCHIE B. VUONG  
PRIMARY EXAMINER

Quochien B. Vuong  
Feb. 04, 2007.